



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,691	12/28/2000	Leonard James Scott	A33888 PCTUSA	5321

21003 7590 10/07/2002

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 10/07/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9/17/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 2, 4, 6-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner repeats his trademark objection set forth in paragraph No. 1 of Paper No. 5 inasmuch as it is still not clear to the Examiner just what the composition of the various varnishes is and such terms as "polefin" wax, "synthetic silicone alternate", "glassene silicone alternate" and whether or not the various percentages refer to weight fraction or some other means of measurement is still unclear.

3. The Examiner has withdrawn his allowance of claims 1 and 2 in paragraph No. 10 of Paper No. 5, together with the objection to claims 6-18 as being dependent upon a rejected base claim in view of the subsequent actions in this Office action.

4. Claims 4 and 6-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in newly amended claim 4 the release strength factor cited therein should be a range of values, not just "between 17 grams force/50 mm" standing alone, as is now the case.

5. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art

Art Unit 1771

to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 4, 6-9, and 11-18 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, a limitation on the "material having a density less than the polyester" presently found in claim 1 and newly added to claim 4 is far in excess of applicants' disclosure, even in a moderately predictable art, and its removal is therefore critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

7. Claims 1, 2, 4 and 6-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Canadian Patent Application 2,172,237, taken either individually or in view of applicants' remarks concerning the prior art on page 1, lines 10-17 of the specification. The reference discloses (note particularly Figures 1, 2, 4 and 5, and the corresponding disclosure, particularly page 3 lines 1-11, page 4 lines 5-16, and particularly page 7 first two paragraphs) substantially an anticipation of the claimed composite label except for a teaching of the material which constitutes the "second layer" and in claim 4 the release strength factor parameter, although the latter in its presently claimed condition is believed to read on almost any

Art Unit 1771

release strength commonly utilized. However, the Examiner respectfully submits that it is well within the ordinary skill of the art to select a suitable material having a density less than polyester, e.g. polypropylene and related films, for example. With respect to the dependent claims, these are each believed to be well known parameters in the label art or ~~clearly~~ parameters such as coefficients of friction and depth dimensions which are clearly parameters that can be easily optimized by one of ordinary skill in, the absence of unexpected results.

8. Claims 1, 2, 4, and 6-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 98/41966, which is also PCT/U.S. 97/18837 which is discussed in applicants' Background of the Invention at page 1 lines 10-17, and earlier cited by the Examiner as an admission by applicants of the prior art. The reference appears to disclose, as applicants apparently admit, a multilayered label having at least one removable sticker from the first layer. Applicants' recitation that such a label is not used in the "soft drink industry" is respectfully submitted to be a patentably insignificant statement of intended contemplated usage, and the utilization of both polyester is admitted on page 2, lines 1-3 of applicants' specification as well known in the label art as a suitable film element for labels. With respect to claim 4 and its attendant dependent claims, the Examiner again believes that the release strength factor as presently claimed is

Art Unit 1771

so broad as to be meaningless, and even if the original range set forth in claims 3 and 4 was reinserted, the Examiner believes that such would be little more than an optimization parameter to one of ordinary skill, in the absence of unexpected results. The dependent claims are again seen as well known variables to one of ordinary skill, in the absence of unexpected results .

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 2, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1988-
1700

Daniel Zirker